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10/043,784	11/07/2001	Michiko Fukuda	15056	7912

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SCULLY SCOTT MURPHY & PRESSER, PC  
400 GARDEN CITY PLAZA  
GARDEN CITY, NY 11530

EXAMINER
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ENG, GEORGE

ART UNIT	PAPER NUMBER
2643	14

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/043,784

Applicant(s)

FUKUDA, MICHIKO

Examiner

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. This office action is in response to the amendment filed 12/11/2003 (paper no. 13).

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 5-10, 13-16 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadowaki et al. (US PAT. 5,414,457) in view of Matsubara et al. (US PAT. 5,345,258 hereinafter Matsubara).

Regarding claim 1, Kadowaki discloses a telephone unit as shown in figure 4 having a telephone directory with picture data comprising video interface (10, figure 3) for receiving compressed image data from a distant station (col. 3 lines 34-35), decoding means (20) for decoding the received compressed image data into an image signal (col. 3 lines 31-32), correlating means (50, figure 3) for correlating the image signal with a telephone number of the distant station (col. 4 lines 4-6), and registering means (41, figure 1) for registering the image signal and the telephone number with the telephone directory (col. 4 line 48 through col. 6 line 17). Kadowaki differs from the claimed invention in not specifically teaching receiving

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compressed moving picture data from the distance party so that first decode means decodes the compressed moving picture data and encoding means encodes one or more frames of the decoded moving picture data into compressed still picture data in order to register. However, Matsubara teaches a videophone capable of storing one frame of received video data, i.e., compressed moving picture data in a storing means using a relatively small amount of storage comprising decoding means (18B, figure 3) for decoding the receiving video signal and encoding means (22B, figure 3) for encoding video signal decoded by the decoding means into a compressed still picture data for storage (col. 4 lines 1-34 and col. 6 lines 13-33). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Kadowaki in capable of receiving compressed moving picture data from the distance party, wherein the telephone unit includes first decode means for decodes the compressed moving picture data and encoding means for encoding one or more frames of the decoded moving picture data into compressed still picture data in order to register, as per teaching of Matsubara, because it can store video signal using a relatively small amount of storage.

Regarding claim 2, Kadowaki discloses to correlate the compressed still picture data with personal information of the distant station, wherein the personal information includes the telephone number of the distant station (col. 4 lines 60-64).

Regarding claim 5, Matsubara discloses a first display means (20B, figure 3) for displaying the decoded moving picture and selecting means (23B, figure 3) for selecting one or more frames to be encoded by the encoding means (22B, figure 3) in response to an operation by a user (col. 4 lines 1-46 and col. 6 lines 13-33).

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Regarding claim 6, Kadowaki discloses second display means as shown in figure 2 for displaying the decoded still image data decoded by decoding means (col. 6 lines 15-34 and col. 5 line 9-38).

Regarding claim 7, Kadowaki teaches to display the decoded still picture when originating a call to the distant station (col. 5 lines 9-23).

Regarding claim 8, Matsubara teaches to display the decoded still picture when terminating a call from the remote station (col. 6 lines 40-58).

Regarding claim 9, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claim 13, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 14, the limitations of the claim are rejected as the same reasons set forth in claim 6.

Regarding claim 15, the limitations of the claim are rejected as the same reasons set forth in claim 7.

Regarding claim 16, the limitations of the claim are rejected as the same reasons set forth in claim 8.

Regarding claim 18, Matsubara teaches the still picture generated by the encoding means is in conformity with a format different from a format with which the moving picture data is in conformity (col. 6 lines 13-33).

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Regarding claim 19, the limitations of the claim are rejected as the same reasons set forth in claim 18.

4. Claims 3-4 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadowaki et al. (US PAT. 5,414,457) in view of Matsubara et al. (US PAT. 5,345,258 hereinafter Matsubara) as applied in claims above, and further in view of Kimura et al. (US PAT. 5,778,054 hereinafter Kimura).

Regarding claim 3, the combination of Kadowaki and Matsubara differs from the claimed invention in not specifically teaching to register the compressed still picture and the telephone number with the telephone directory in JPEG format in which the telephone number is being recorded in a comment segment of a JPEG file. However, Kimura teaches a storage device storing access information, i.e., telephone numbers, corresponding to image information, wherein the access information and the image information are registered in JPEG format so that it recognizes the access information being recorded in a comment segment of a JPEG file in order to simplify physical structure and intuitive graphical user interface (col. 4 line 29 through col. 6 line 10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Kadowaki and Matsubara in registering the compressed still picture and the telephone number with the telephone directory in JPEG format in which the telephone number is being recorded in a comment segment of a JPEG file, as per teaching of Kimura, because it simplifies physical structure and intuitive graphical user interface.

Regarding claims 4 and 11-12, the limitations of the claims are rejected as the same reasons set forth in claim 3.

***Response to Arguments***

5. Applicant's arguments filed 12/11/2003 (paper no. 13) have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., bi-directional correlation means) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Contrary to applicant's argument that neither Kadowaki nor Matsubara teaches converting one or more frames of a moving picture into compressed still picture data and then correlating the still picture with a number in a telephone directory, Kadowaki clearly teaches to decode the received compressed image data into an image signal and then to correlate the image signal with a telephone number in a telephone directory (col. 3 lines 31-32 and col. 4 lines 4-6), and Matsubara clearly teaches to convert one frame of a video signal into compressed still image in order to minimize the use of memory space for registering video signal. Since the claimed language merely states encoding means for encoding **one frame** or more frames of the decoding moving picture data into a compressed still image data. Thus, the combination of Kadowaki and Matsubara is enough to reject the claimed limitations.

Contrary to applicant's argument that one would not be motivated to combine Kadowaki, Matsubara and Kimura since the moving picture encoding of Kadowaki and Matsubara would not be compatible with the still image or JPEG encoding of Kimura, the examiner recognizes that

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obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the combination of Kadowaki and Matsubara with Kimura because it simplifies physical structure and intuitive graphical user interface. In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Thus, the claimed limitations of claims 3-4 and 11-12 are rejected by the combination of Kadowaki, Matsubara and Kimura.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

6. Any response to this final action should be mailed to:

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Or faxed to:



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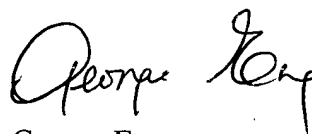
(703) 872-9314 (for Technology Center 2600 only)

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, V.A., Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tuesday to Friday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz, can be reached on (703) 305-4870. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



George Eng  
Examiner  
Art Unit 2643